

REMARKS

Claims 1-3, 5 and 25-28 remain pending in the application. Claims 4, 6-24 and 29 have been canceled and Claims 1, 2, 3, 5 and 25 have been amended. Claims 1 and 25 are the remaining independent pending claims.

Section 102(e) and 103(a) rejections

Claims 1-2, 10-11, 15-16, 20-21 and 25-29 were rejected under 35 USC 102(e) as anticipated by US Patent 6,446,130 (Grapes), and Claims 3-9, 12-14, 17-19 and 22-24 were rejected under 35 USC 103(a) as being unpatentable over Grapes in view of US Patent 6,385,595 (Kolling et al.). In view of the foregoing claim cancellations and amendments, and the following remarks, each of the rejections is respectfully traversed and reconsideration is requested.

Independent Claim 1 has been amended to include the limitations of now canceled dependent Claim 7, and independent Claim 25 has been amended to include the limitations of now canceled dependent Claim 29.

Independent Claim 1

Independent Claim 1 (again, as amended herein to include the limitations of now canceled dependent Claim 7) is directed to a method for preparing graphical content associated with corresponding digital audio content, including receiving the graphical content associated with the corresponding audio digital content from a digital database and preparing the graphical content for packaging with the corresponding digital audio content by implementing at least one format conversion. The format conversion includes utilizing a first software program to manipulate the digital graphical content, creating postscript files corresponding to the digital graphical content, manipulating the postscript files corresponding to the graphical content utilizing a second software program, creating PDF files corresponding to the digital graphical content and printing the PDF files.

The amendment to Claim 1 to include the limitations of Claim 7, renders the 102(e) rejection of Claim 1 moot – therefore the following arguments address the rejection of dependent Claim 7 over the alleged combination of teachings of Grapes and Kolling.

Grapes is directed to a multimedia delivery system capable of “providing multiple streams of content to users...allowing users to interact with the system....providing information concerning the users to a centralized computer...providing users with the ability to perform financial transactions...and provide a printed receipt or redemption coupon” (Abst, emphasis added).

Grapes, as acknowledged in the Action, does *not teach or suggest* a method for preparing graphical content associated with corresponding digital audio content, including receiving the graphical content associated with the corresponding audio digital content from a digital database and preparing the graphical content for packaging with the corresponding digital audio content by implementing at least one format conversion – in which the format conversion includes (1) utilizing a first software program to manipulate the digital graphical content, (2) creating postscript files corresponding to the digital graphical content, (3) manipulating the postscript files corresponding to the graphical content utilizing a second software program, and (4) creating PDF files corresponding to the digital graphical content and printing the PDF files.

The section of Grapes cited, col. 3, lines 41-48, simply describes that the system of Grapes “can also include a printer....to deliver to the user physical output from the system...including promotional materials that can be used to further enhance the marketing of an advertiser’s product or services”.

There would simply be no teaching or suggestion to one of ordinary skill in the art to combine the teachings of Grapes and Kolling in the manner suggested – and in particular, to modify Grapes “by employing commercially available software packages taught by Kolling for their ubiquitous use in desktop publishing and printable materials” (see para of OA bridging pages 8-9).

Grapes is directed to the “ability of advertisers to effectively target specific audiences and obtain direct consumer feedback regarding the effectiveness of their advertising” (col. 1, lines 26-28). One of ordinary skill in the art would have absolutely no motivation to combine the teachings of Grapes and Kolling in the manner proposed in the Action – Grapes merely notes that “promotional materials” may be printed.

There is no teaching or suggestion in Grapes, at all, to “prepare” graphical content (associated with corresponding digital audio content) by implementing at least one format conversion – in which the format conversion includes (1) utilizing a first software program to manipulate the digital graphical content, (2) creating postscript files corresponding to the digital graphical content, (3) manipulating the postscript files corresponding to the graphical content utilizing a second software program, and (4) creating PDF files corresponding to the digital graphical content and printing the PDF files.

For at least the foregoing reason, Applicants respectfully submit that independent Claim 1 is patentable over any permissible combination of the teachings of Grapes Kolling and reconsideration is requested.

Independent Claim 25

Independent Claim 25 (amended herein to include the limitations of now canceled dependent Claim 29) is directed to a method for transmitting media to a consumer over a public computer network including transmitting a digital media file over the computer network to a user’s personal computer in response to a user’s request for the digital media file, transmitting a graphics file associated with the digital media file to the user’s personal computer over the computer network, and printing the graphics file and attaching the printed graphics to the computer readable medium.

In the rejection of Claim 29 (page 7), the Action notes that “Grapes teach...printing the graphics file and attaching the printed graphics to the computer readable medium [col. 3, lines 9-55]”.

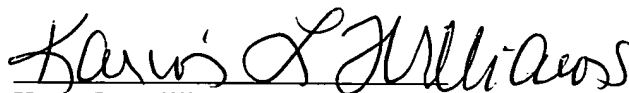
Applicant respectfully submits that Grapes does *not* teach or suggest printing the graphics file and attaching the printed graphics to the computer readable medium. Again, as noted above with respect to Claim 1, Grapes merely describes that its system “can also include a printer....to deliver to the user physical output from the system...including promotional materials that can be used to further enhance the marketing of an advertiser’s product or services” (col. 3, lines 41-48).

For at least the foregoing reason, Applicants respectfully submit that independent Claim 25, as amended herein, is not anticipated by Grapes, and reconsideration is requested.

Dependent Claims 2-3, 5 and 26-28 are believed to be clearly patentable for all of the reasons indicated above with respect to Claims 1 and 25, one or the other from which they depend, and even further distinguish over the cited references by reciting additional limitations.

It is respectfully submitted that in regard to the above remarks that the pending application is patentable over the art of record and reconsideration is accordingly requested. Should the Examiner be of the view that an interview would expedite consideration of this Amendment or of the application at large, request is kindly made that the Examiner telephone Applicants' undersigned attorney at (908) 518-7700 in order that any outstanding issues may be resolved.

Respectfully submitted,



Karin L. Williams

Registration No. 36,721

Certificate of Mail

I hereby certify that this document and any document referenced herein is being deposited with the US Postal Service as first class mail under 37 C.F.R. 1.8 and addressed to
Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on March 4, 2004

Karin L. Williams, Reg. No. 36,721

(Printed Name of Person Mailing Correspondence)


(Signature)

Please Continue To Send All Correspondence to:

Mayer, Fortkort & Williams PC
251 North Avenue West, Second Floor
Westfield NJ 07090

(908) 518-7700
(908) 518-7795 fax